

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Tsumoru MATSUURA, et al.

Serial No.: 09/437,499

Filed: November 10, 1999

For: IMAGE FORMING APPARATUS



Customer Number: 20277

Confirmation Number: 8064

Group Art Unit: 2622

Examiner: WALLERSON, Mark E.

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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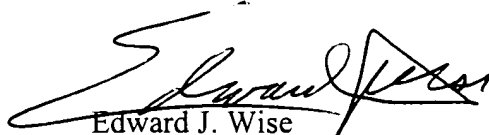
Sir:

Submitted herewith in triplicate is Appellant(s) Appeal Brief in support of the Notice of Appeal filed August 11, 2003. Please charge the Appeal Brief fee of \$330.00 to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Docket No.: 44376-028

PATENT

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Sir:

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal of the final rejection of claims 1-6, 9, 12-15 and 17-20, filed August 11, 2003.

I. REAL PARTY IN INTEREST

The real party in interest is MINOLTA CO., LTD. (operating as KONICA MINOLTA HOLDINGS, INC. as of October 1, 2003).

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II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-23 are pending in this application, of which claims 7, 8, 10, 11, 16 and 21-23 are indicated as being allowable. Claims 1-6, 9, 12-15 and 17-20 have been finally rejected. It is from the final rejection of claims 1-6, 9, 12-15 and 17-20 that this Appeal has been taken.

IV. STATUS OF AMENDMENTS

A proposed amendment was filed under 37 CFR § 1.116 on July 22, 2003, making minor amendments to claims 11 and 23. The Advisory Action, dated August 26, 2003, made no indication as to whether or not the proposed amendment would be entered for purposes of appeal. The amendment to claim 11 corrected a punctuation and the amendment to claim 23 corrected an error in the claim, by providing additional language to separate the sheet means into a "sheet processing unit for performing the post handling of the sheets" and "a setting means for setting a post handling condition of the discharged sheets..." Since claims 11 and 23 are indicated allowable, and the change to claim 23 does not broaden the scope thereof, it is assumed that these amendments have been entered for purpose of appeal.

V. SUMMARY OF THE INVENTION

The present invention is directed to an image forming apparatus having a plurality of trays for receiving discharged sheet(s) bearing a formed image. With this apparatus, the layout

of the printed pages that are to be discharged into each of the plurality of trays (FIGS. 4-13) can be freely set (e.g., by means of an operational display panel), with respect to each of the plurality of trays. The layout can include, for example, N pages of image on one sheet of paper (Nin1) processing, double-sided printing, paper size setting, margin setting, stapling, perforation, folding, sorting, water marking, printing of serial numbers, impression of printing time, enlarging size and reducing image size.

After the layout of printed pages has been set, when a user selects the destination (any of the plurality of trays) of discharged sheets, the apparatus determines if the tray selected as the destination of discharged sheets has been set as to a layout of the printed pages, and if it has, the an image forming unit of the apparatus will form an image on the sheets in the layout that has been set to this selected tray, eliminating the need of a user to set such layout for each printing job. More specifically, by merely (knowing and) designating a specific tray (that has been set as to a specific layout of the printed pages) as the destination of discharged sheets, the image forming apparatus will automatically discharge sheets to the designated tray with the specific layout set to the designated tray (steps S204 through S209; FIG. 14; page 17, lines 6 through page 19, line 6).

Claim 1 is presented below with elements read on the specification and drawings, as suggested in MPEP § 1206.

An image forming apparatus comprising:

a plurality of trays for receiving discharged sheets bearing a formed image (11a-11d; FIG. 1; page 5, lines 3-8),

a setting means for selectively setting the form of output with respect to at least one of said plurality of trays (132, 133; FIGS. 2-13; page 5, line 18 through page 6, line 15, page 8, line 22 through page 15, line 17), and

an image forming unit (14, 18 and 17; FIG. 3, page 7, line 17 through page 8, line 13) for forming an image on the sheets in the form of output set by said setting means when the tray which the form of output has been set is selected as the destination of discharged sheet (S204; FIG. 14; page 17, lines 6-23).

VI. ISSUE

A. The Rejections

Claims 1-5, 9, 12-15, 17 and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by Kida [et al.] (USPN 5,852,764, filed on May 13, 1997 and issued on December 22, 1998).

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kida [et al.] in view of Matsui [et al.] (USPN 5,921,537, filed on March 12, 1997 and issued on July 13, 1999).

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kida [et al.] in view of Taneda [et al.] (USPN 5,236,185, filed on July 10, 1991 and issued on August 17, 1993).

B. Issues

The Issues which arise in this Appeal and requires resolution by the Honorable Board of Patent Appeals and Interferences (Board) is whether claims 1-5, 9, 12-15, 17 and 20 are unpatentable under 35 U.S.C. § 102 for lack of novelty predicated upon Kida [et al.], whether claim 6 is unpatentable under 35 U.S.C. § 103 for obviousness predicated upon Kida [et al.] in view of Masui [et al.], and whether claims 18 and 19 are unpatentable under 35 U.S.C. § 103 for obviousness predicated upon Kida [et al.] in view of Taneda [et al.].

VII. GROUPING OF CLAIMS

Claims 1-5, 6 and 9 stand or fall together as a group depending upon the patentability of independent claim 1, claims 12-15 stand or fall together as a group depending upon the patentability of independent claim 12, and claims 17-20 stand or fall together as a group depending upon the patentability of independent claim 17.

VIII. THE ARGUMENT

(i) The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Appellants urge that there are a significant differences between the claimed invention and the arrangement disclosed by Kida [et al.] that scotch the factual determination that Kida [et al.] identically describes the inventions recited in independent claims 1, 12 and 17.

A. Independent claim 1 recites, *inter alia*:

a plurality of trays for receiving discharged sheets bearing **a *formed*** image,
a setting means for selectively setting **the *form*** of output with respect to at
least one of said plurality of trays, and
an image forming unit for ***forming an image on the sheets in the form of
output*** set by said setting means ***when the tray which the form of output has
been set is selected as the destination of discharged sheet.*** (Emphasis added)

Thus, what is required in claim 1 is that the image forming unit forms the image on the sheet in the form of output that has been set when the tray with which the form of output has been set is selected as the sheet discharge destination. More specifically, after a tray has be set as to a form of output, a sheet(s) containing this form of output will be output to this tray by merely selecting this tray as the destination of the discharged sheet(s). No additional setting need be made on the image forming apparatus in order to discharge a sheet(s) to this tray having the set form of output.

In general, Kida [et al.] discloses setting “post image forming processing” with respect to each image forming mode. The “post image forming processing” is clearly disclosed in Kida [et al.] to be the “discharge state” of the sheets P (with images formed on them are), and the “discharge state” of the sheets P is either with the images face-up, or images face-down. However, discharging of sheets P with either the formed images face-up, or with the formed images face-down, is clearly unrelated to actually ***forming an image(s) on the sheet in the form***

that has been set by a setting means, by selecting the tray, for which that form of output has been set by the setting means, as the sheet discharge destination. There is nothing done to a sheet in Kida [et al.], during forming of an image, that causes it to be discharged with either the formed images face-up, or with the formed images face-down. A processing done to the sheet after the image has been formed is what causes it to be discharged with either the formed images face-up, or with the formed images face-down.

Kida [et al.] also describes that the disclosed arrangement has a double-sided copy mode. The Examiner refers (see Advisory Action of August 26, 2003) to column 30, lines 46-57 of Kida [et al.] as evincing that the reference discloses an image forming unit *for forming an image on the sheets in the form of output set by said setting means when the tray which the form of output has been set is selected* as the destination of discharged sheet, noting that “when discharge tray 53 or 59 is selected, *double sided copying* is performed”.

Column 30, lines 46-57 describe:

It may be arranged such that the sheet P having an image formed thereon is not discharged directly onto the tray but sent back to an image forming section, and a subsequent sheet P having an image formed thereon can undergo a post-processing operation. In this case also, in order to return the sheet P to the digital copying machine main body 1, one of the first and second discharge trays 53 and 59 is selected. Namely, in the image forming mode, *when the double-sided copy mode is selected, which one of the first or second discharge trays 53 and 59 is to be selected is set beforehand*, and upon completing an image forming process on both sides of the sheet P, the sheet P is discharged onto the discharge tray as selected. (Emphasis added)

Even though double-sided copying is *forming an image(s) on the sheet in the form set* [by a setting means], the above noted portion of Kida [et al.] does not establish that each element of claim 1 is found in Kida [et al.], either expressly described or under principles of inherency, as

is required to establish anticipation under 35 U.S.C. § 102. The above identified portion of Kida [et al.] describes the fact that a user sets beforehand, which one of trays 53 and 59 is to be used when reversing a sheet during the double-sided copy mode, as well as the tray to be used as the discharge tray (see column 30, lines 58-59). Given the fact that more than one double-sided copy sheet will likely be discharged to the selected discharge tray, it is unreasonable to presume that Kida [et al.] permits the same tray to be used when reversing a sheet during the double-sided copy mode, as well as to be used as the discharge tray to receive the sheets having images formed on both side, since such dual use would complicate the reversing operation (jamming could result).

Even if it is presumed that the arrangement of Kida [et al.] uses the tray that is selected for reversing a sheet during the double-sided copying mode, as well as the tray selected to receive the discharged sheet(s) having the double-sided copy images, for all double-sided copying operations until the selections are purposely changed (by the user selecting other trays to be used for each of these operations), it is clear from the entire disclosure of Kida [et al.] that the double-sided copy mode is selected, not by designating the selected tray as the destination of a discharged sheet, ***but by selecting the function using key 23*** (again, see column 13, lines 22-23). More specifically, trays 53 and 59 are described as being used in conjunction with different functions and/or copy modes. In particular, both trays can be used during a single side copy operation (not just the double-sided copy mode). Consequently, it is unrealistic to presume that mere selection of tray 53 or 59 as the destination of a discharged sheet(s) would lead to the sheet(s) being discharged containing images on both sides. This is true also, even if Kida [et al.]

somehow could use the same tray for reversing a sheet during the double-sided copying mode, as well for receiving the discharged sheet(s) having the double-sided copy images,

On the contrary, in Kida [et al.], when intending to discharge sheets having images formed on both sides, the ***double-sided copy mode must first be selected using key 23***, and then the arrangement of Kida [et al.] uses the tray that has been selected (beforehand) to reverse a sheet during double-sided copying, and uses the tray that has been selected (beforehand) to receive a discharged sheet(s) with images formed on both sides to (see column 30, line 58-59). This is clearly different than what is required by independent claim 1; i.e., that the form of output is (selectively) set with respect to at least one tray and then an image is formed on sheets in the form of output that has been (selectively) set to that tray by selecting that tray as the destination of discharged sheet.

Thus, each element of claim 1 is **NOT** found in Kida [et al.], either expressly described or under principles of inherency.

B. Independent claim 12 recites, *inter alia*:

a setting means for selectively ***setting the size of sheet*** with respect to at least one of said plurality of trays, and

an image forming unit for ***supplying sheets of the size set*** by said setting means and forming an image on the supplied sheet ***when the tray which the size of sheet has been set is selected*** as the discharged destination. (Emphasis added)

There is absolutely no disclosure or suggestion in Kida [et al.] of ***supplying sheets of a size set by a setting means***, by selecting the tray, for which that size sheet has been set by the setting means, as the sheet discharge destination. While Kida [et al.] does disclose setting via a tray the “discharge state” of sheets P (with images formed on them are), which is either with the

images face-up, or images face-down, there is clearly nothing described about setting, to one of a plurality of discharge trays, a particular size sheet on which an image is to be formed, and then forming an image on the particular size sheet by selecting that tray as the sheet discharged destination for the sheets on which the image is formed.

Thus, each element of independent claim 12 is **NOT** found in Kida [et al.], either expressly described or under principles of inherency.

C. Referring now to independent claim 17, as shown in Fig. 8 of Kida [et al.] and the accompanying description thereof, Kida [et al.] discloses the technology to set the combination of discharge trays (1 or 2) and REVERSE (YES or NO) for the each image formation mode (COPY MODE, FAX MODE or PRINTER MODE) from the operation panel. As stated at column 19, lines 46-60, the various combination of discharge trays (1 or 2) and REVERSE (YES or NO) are preset in a table as discharge modes A, B, C and D, and the discharge mode that is used is selected according to the chosen image formation mode (see, Fig. 10).

If COPY MODE is chosen as an image formation mode, for example, MODE # (TRAY:1, REVERSE:NO) is automatically selected, and in the same way, if PRINTER MODE is chosen, MODE A (TRAY:1, REVERSE: YES) is selected. Consequently, the setting of REVERSE is not always the same, even if the same tray is selected. This means that REVERSE, which is a post handling of sheets, has not been set for trays, but for image formation modes.

In contrast, the present invention set forth in independent claim 17, has the element “a setting means for selectively setting a post handling condition of discharged sheets with respect

to at least one of said plurality of tray". That is, post handling conditions of discharged sheets are selectively set for discharge trays in advance.

The present invention also has the element "a sheet processing unit for performing the post handling of sheets based on the post handling condition set by said setting means when the tray which the post handling condition has been set is selected as the discharged destination". Namely, when the discharge tray is chosen and the image forming process is executed, discharged sheets are processed under the post handling condition, which has been set for the chosen discharge tray. The user can, therefore, easily obtain uniform printed matter for multiple jobs merely by choosing the discharge tray.

As mentioned above, although Kida [et al.] describes to set the combination of discharge trays and REVERSE (YES or NO) for the each image formation mode, the reference fails to disclose or suggest the elements "a setting means" and "a sheet processing unit" that are recited in independent claim 17 of the present application.

Thus, each element of claim 17 is **NOT** found in Kida [et al.], either expressly described or under principles of inherency.

Conclusion

The above argued differences between the claimed apparatus vis-à-vis the apparatus of Kida [et al.] undermine the factual determination that Kida [et al.] identically describe(s) the claimed invention(s) within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81

(Fed. Cir. 1986). Appellants, therefore, submit that the imposed rejection of independent claims 1, 12 and 17 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kida [et al.] is not factually or legally viable.

Appellants, therefore, submit that the imposed rejection of claims 1-5, 9, 12-15, 17 and 20 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kida [et al.] should not be sustained as the Examiner has not met the statutory requirements for anticipation as each element of independent claims 1, 12 and 17 is **NOT** found in Kida [et al.], either expressly described or under principles of inherency.

Furthermore, it should be apparent that, as the Examiner has not met the statutory requirements for anticipation as to independent claims 1, 12 and 17, the imposed rejection of dependent claim 6 under 35 U.S.C. § 103 as being unpatentable over Kida [et al.] in view of Matsui [et al.], and the imposed rejection of dependent claims 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Kida [et al.] in view of Taneda [et al.] should not be sustained also.

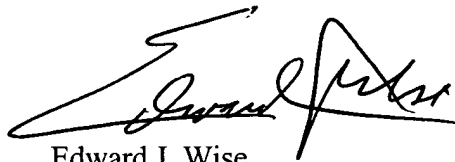
IX. PRAYER FOR RELIEF

Based upon the above arguments, Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection of claims 1-5, 9, 12-15, 17 and 20 under 35 U.S.C. § 102 for lack of novelty predicated upon Kida [et al.], as well as the Examiner's rejections of claim 6 under 35 U.S.C. § 103 for obviousness predicated upon Kida [et al.] in view of Matsui [et al.] and of claims 18 and 19 under 35 U.S.C. § 103 for obviousness predicated upon Kida [et al.] in view of Taneda [et al.].

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over a horizontal line.

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APPENDIX

1. (Appealed) An image forming apparatus comprising:
a plurality of trays for receiving discharged sheets bearing a formed image,
a setting means for selectively setting the form of output with respect to at least one of
said plurality of trays, and
an image forming unit for forming an image on the sheets in the form of output set by
said setting means when the tray which the form of output has been set is selected as the
destination of discharged sheet.
2. (Appealed) An image forming apparatus according to claim 1, wherein said setting
means comprises a selector for selecting one tray from said plurality of trays and sets the form of
output with respect to the tray selected by said selector.
3. (Appealed) An image forming apparatus according to claim 1, wherein said setting
means sets the form of output with respect to each of said plurality of trays.
4. (Appealed) An image forming apparatus according to claim 1, wherein said form of
output serves the purpose of forming images each on the obverse and the reverse side of a sheet.
5. (Appealed) An image forming apparatus according to claim 1, wherein said form of
output serves the purpose of forming images of a plurality of pages on one sheet.

6. (Appealed) An image forming apparatus according to claim 1, wherein at least one of said plurality of trays is allocated to a specific user as a discharged destination.

9. (Appealed) An image forming apparatus according to claim 1, which further comprises a receiving means for receiving data concerning the discharged destination and the form of output and an image data as a set, said image forming unit serving the purpose of forming an image on sheets based on the image data received by said receiving means.

12. (Appealed) An image forming apparatus comprising:
a plurality of trays for receiving discharged sheets bearing a formed image,
a setting means for selectively setting the size of sheet with respect to at least one of said plurality of trays, and
an image forming unit for supplying sheets of the size set by said setting means and forming an image on the supplied sheet when the tray which the size of sheet has been set is selected as the discharged destination.

13. (Appealed) An image forming apparatus according to claim 12, wherein said setting means comprises a selector for selecting one tray from said plurality of trays and sets the size of sheets to be discharged to the tray selected by said selector.

14. (Appealed) An image forming apparatus according to claim 12, wherein said setting means sets the sizes of sheets to be discharged respectively to said plurality of trays.

15. (Appealed) An image forming apparatus according to claim 12, which further comprises a receiving means for receiving the data concerning the discharged destination and the size of sheets and an image data as a set, said image forming unit serving the purpose of forming an image on sheets based on the image data received by said receiving means.

17. (Appealed) An image forming apparatus comprising:
a plurality of trays for receiving discharged sheets bearing a formed image,
a setting means for selectively setting a post handling condition of discharged sheets with respect to at least one of said plurality of trays, and
a sheet processing unit for performing the post handling of sheets based on the post handling condition set by said setting means when the tray which the post handling condition has been set is selected as the discharged destination.

18. (Appealed) An image forming apparatus according to claim 17, wherein said post handling of sheets is a processing for stapling a bundle of sheets.

19. (Original) An image forming apparatus according to claim 17, wherein said post handling of sheets is a processing for punching sheets.

20. (Appealed) An image forming apparatus according to claim 17, which further comprises a receiving means for receiving the data concerning the discharged destination and an

image data as a set, said image forming unit serving the purpose of forming an image on sheets based on the image data received by said receiving means.

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